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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,943	11/13/2003	Gary Workman	00290P0021US	9536
32116 7590 07/20/2007 WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			EXAMINER DESAI, ANISH P	
			ART UNIT 1771	PAPER NUMBER
			MAIL DATE 07/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/712,943

Applicant(s)

WORKMAN, GARY

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-12 is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 03/26/07, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing this Office Action.

2. The 35 USC Section 102 rejections based on Kelch et al. (US 5,695,870) are withdrawn, because Kelch does not teach or suggest a test apparatus as required by claim 1.
3. The 35 USC Section 103 rejections based on Kelch et al. (US 5,695,870) alone are maintained.
4. The 35 USC Section 103 rejections based on Hadley et al. (US 3,545,263) in view of Peacock (US 4,534,225) and Wilhelm Muhm (US 3,295,278) are withdrawn,

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because there is no motivation to combine the reference of Wilhelm Muhm with combined teaching of Hadley and Peacock.

5. A new 35 USC Section 112-second paragraph rejection is made.

Allowable Subject Matter

6. Claims 7-12 are indicated as allowable over all of the prior art of record for the reasons set forth below.

The closest prior art to claims is Hadley et al. (US 3,545,263) in view of Peacock (US 4,534,225) and Wilhelm Muhm (US 3,295,278).

Hadley generally discloses a testing system for compression testing of concrete masonry units having upper and lower platens (title and column 1 lines 53-59).

However, Hadley is silent with respect to teaching a pair of compression pads each comprising a rigid, rectangular foam board wherein a plastic sheet is laminated to the rigid foam board. Peacock discloses a method and apparatus for supporting concrete testing samples (abstract) for use in compression testing of the concrete samples.

Further, Peacock discloses molded elastomeric pads that are positioned over the ends of the cylindrical concrete samples (column 1, lines 9-12). However, Peacock is silent with respect to teaching a rigid, rectangular foam board of a size to be received on one face of a concrete masonry unit and a plastic sheet laminated to the rigid foam board and being engageable by one of the test platens in use. The reference of Wilhelm Muhm does not remedy the aforementioned deficiencies of Hadley and Peacock, because Wilhelm Muhm's reference is directed towards a laminated load bearing structure where the structure of Muhm's invention is a concrete panel including an

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interior foam body. Additionally, there is no disclosure in Mhum's reference that it can be used in compression testing of concrete. There is no motivation to combine the reference of Wilhelm Muhm with Hadley and Peacock. Accordingly, claims 7-12 are allowable.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6 and 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "An unbounded capping system for strength testing of concrete masonry units, comprising a test apparatus". From the specification, it seems that the unbonded capping system of the presently claimed invention includes a plastic sheet that is laminated to a rigid foam board (page 2 lines 10-14 and page 4 line 14); the capping system does not include a test apparatus. Thus, the structure of the capping system is difficult to ascertain. The capping system does not comprise a test apparatus; instead test apparatus (testing system) comprises the capping system. Similar is true for claim 13, which recites "In a capping system for compression testing of concrete masonry unit including first and second platens". The capping system does not include first and second platens; instead the apparatus that is used for compression testing of concrete masonry units includes first and second platens and the capping system.

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Since claims 2-6 depend from claim 1 and claims 14-18 depend from claim 13, these claims are rejected as well.

In order to overcome this rejection, if Applicant chooses to amend the preamble of claims 1 and 13 to for example, a "testing system" then it is believed that claims 1 and 13 would be substantially duplicate of each other, and claim 7. Then, claims 1 and 13 will be objected for double patenting in accordance with 37 CFR 1.75 (MPEP 706.03(k)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelch et al. (US 5,695,870).

Regarding claim 19, the recitation "for strength testing of concrete masonry unit" is not given any patentable weight because such is an intended use of the unbonded capping system. Additionally, with respect to recitation "An unbonded capping system", from the specification, it seems that the unbonded capping system of the applicant only includes a plastic sheet that is laminated to a rigid foam board (page 2, lines 10-14 and page 4, line 14 of specification). Therefore, any reference disclosing a pair of laminated compression pads having high density expanded polystyrene foam wherein a plastic

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sheet is laminated to each of the compression pads will read on the unbonded capping system, and it will be functionally capable of being used in the strength testing of concrete masonry units. Further, the test apparatus as recited in the body of claim 19 does not constitute any structural part of the unbonded capping system of the presently claimed invention for the reasons given above.

Regarding claim 19, Kelch discloses a laminated foam insulation board having enhanced strength and resistance to bending and breaking (abstract). Further, Kelch discloses a thermoplastic facer film adhered to a plastic foam (abstract), wherein the plastic foam of Kelch is formed of expanded polystyrene (column 4, lines 32-33). With respect to claim 20, Kelch discloses that polystyrene foams have density of from about 10 kg/m^3 to about 150 kg/m^3 , which reads on applicant's claimed polystyrene foam board having density of about 3 lb/ft^3 (48 kg/m^3).

The difference between the prior art of Kelch and the presently claimed invention is that Kelch is silent as to teaching a pair of laminated compression pads, however since Kelch already discloses one laminated compression pad (a plastic film laminated to expanded polystyrene foam), it would have been obvious to provide a second compression pad because doing so would involve a routine skill in the art.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelch et al. (US 5,695,870) in view of Link Jr. et al. (US 4,566,558).

The invention of Kelch is previously disclosed. Kelch further discloses a foam board having thickness of about 0.25 inch to about 1 inch (column 4, lines 43-44), which meets the claim requirement of EPS foam layer having a thickness of about 0.5 inch.

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Kelch is silent as to teaching of plastic sheet has a thickness of about 0.06 inches. However, Link teaches a noise barrier with plastic foam slabs attached to and sandwiched between a plastic sheets (abstract). The plastic foam slab of Link includes polystyrene foam (column 4, lines 4-5). Further Link teaches the thickness of the plastic foam to be about 0.06 inches. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to laminate a plastic film with thickness of 0.06 inches to polystyrene foam of Kelch because it known in the art to laminate a polystyrene foam with a plastic film with thickness of 0.06 inches.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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